



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/702,194

11/04/2003

Stephen Solomon

11973-003

7107

21890 7590 05/19/2009

PROSKAUER ROSE LLP  
PATENT DEPARTMENT  
1585 BROADWAY  
NEW YORK, NY 10036-8299

EXAMINER

HAND, MELANIE JO

ART UNIT

PAPER NUMBER

3761

MAIL DATE

DELIVERY MODE

05/19/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**UNITED STATES PATENT AND TRADEMARK OFFICE**

---

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

---

*Ex parte* STEPHEN SOLOMON, MOSHE SHIKE,  
and SAM KLEIN

---

Appeal 2008-004105  
Application 10/702,194  
Technology Center 3700

---

Decided:<sup>1</sup> May 19, 2009

---

Before DONALD E. ADAMS, LORA M. GREEN, and  
JEFFREY N. FREDMAN, *Administrative Patent Judges*.

FREDMAN, *Administrative Patent Judge*.

---

<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

## DECISION ON REQUEST FOR REHEARING

Appellants have requested rehearing (reconsideration) of the decision entered December 1, 2008. That decision affirmed the Examiner's rejection of claims 17, 18, and 32-34 under 35 U.S.C. § 103(a).

Appellants' request has been granted to the extent that the decision has been reconsidered, but such request is denied with respect to making any modifications to the decision affirming the examiner's rejection under 35 U.S.C. § 103(a).

## DISCUSSION

Appellants contend that "the Board misapprehended Shapiro, and Appellants further submit that FF1 is insufficient to rebut Appellants' contention" (Req. Recons. 4). Appellants contend that "following Shapiro's teachings would lead a person looking for obesity treatments to try regimens that decrease food intake, and avoid regimens that increase food intake" (Req. Recons. 4). Appellants contend that "since Shapiro also teaches that sham feeding increases meal size . . . following Shapiro's teachings would actually lead a person to avoid sham feeding as a treatment of obesity" (Req. Recons. 4).

We have reconsidered the evidence in its entirety. We are unpersuaded by Appellants' arguments because the ordinary artisan would recognize that while the sham feeding of Shapiro might increase food intake, that increased feeding operates "in such a way that the animal eats or drinks without receiving nutritional benefits" (Shapiro 125; Board Dec., FF 5). It is the presence or absence of nutritional benefits, not the amount of food intake, which determines whether the method will function as a treatment for obesity. That is, even if food intake is increased, if calories and nutrition are

not increased, then the method will function to treat obesity. In the context of sham feeding, it is nutritional benefit and calorie intake, not meal size, which determine whether the subject will gain or lose weight.

Shapiro recognizes the centrality of nutritional benefit, noting that “[b]y use of this arrangement which roughly and most ‘dramatically’ mimics the eating-without-calories strategy of bulimia, a host of other variables including dieting . . . can be and have been explored in the exhaustive and recursive way that is characteristic of the research enterprise” (Shapiro 127). In this discussion, Shapiro expressly links dieting, which is a treatment for obesity, with sham feeding (*see* Shapiro 127). Shapiro recognizes that sham feeding is an intervention which reduces nutrition (*see* Board Dec., FF 5, 7) and that Shapiro suggests that interventions which reduce nutrition serve as potential obesity treatments (*see* Board Dec., FF 1). Thus Appellants have not demonstrated that given these two teachings of Shapiro, the ordinary practitioner of ordinary creativity would have found it obvious to employ sham feeding as a treatment for obesity.

#### SUMMARY

Appellants’ request has been granted to the extent that the decision has been reconsidered, but such request is denied with respect to making any modifications to the decision affirming the examiner's rejection under 35 U.S.C. § 103(a).

DENIED

Appeal 2008-004105  
Application 10/702,194

cde

PROSKAUER ROSE LLP  
PATENT DEPARTMENT  
1585 BROADWAY  
NEW YORK NY 10036-8299